

Atty. Dkt. No. 1-002 AMENDMENT AFTER FINAL

Appl. No. 09/513,656
Amdt. Aft FINAL dated January 26, 2006
Reply to Office Action

REMARKS

Claims 1-25, 27-28, and 38-47 are pending and stand rejected; with Claims 1-3, 11, 12, 15-17, 21, 23-25, 27 and 38-39 rejected under 35 U.S.C. § 102 novelty, and Claims 4, 5, 6, 9, 10, 13, 14, 18-20, 22, 28, 40-43 and 45-47 under 35 U.S.C. § 103 for obviousness. Claims 7, 8 and 44 stand rejected under 35 U.S.C. § 112, second paragraph, which claims are hereby amended to recite the player (i.e., the player includes the fob-like structure that allows the player to be clipped to clothing, etc.) to overcome the § 112, second paragraph rejection. The examiner is requested to please acknowledge the change the attorney docket number to 1-002 submitted with the powers of attorney mailed March 16, 2005.

REQUEST TO WITHDRAW THE FINALITY OF ACTION

The first action on applicants' pending application filed February 25, 2000, was mailed November 17, 2004. Presently the Examiner introduces new grounds of rejection that were neither necessitated by the amendment nor based on filed information disclosure statement, and thus the Final Rejection is Premature and should be withdrawn pursuant to 37 C.F.R. § 1.116 and MPEP § 706.07, (a), (c)-(e). The action should have been Non-Final. As discussed further below among the new grounds raised in the latest action, Original Claim 3 and previously presented Claim 27 are for the first time rejected under 35 U.S.C. § 102 novelty. Accordingly applicants instant reply and request for reconsideration further requests withdrawal of the Final Rejection because of its being premature due to the introduction of the new grounds of rejection. "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement" see MPEP § 706.07 (a). New grounds were not necessitated by applicants. "Any question as to prematureness of a final rejection should be raised, if at

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all, while the application is still pending before the primary examiner" see MPEP § 706.07 (c).

THE DOUBLE PATENTING OBJECTIONS ARE IMPROPER

The Examiner asserts double patenting (which is normally raised between different patent application filings) as between Claims 9 and 10, and 45 and 46 within this single pending application. The double patenting objections should be withdrawn from the action. Notwithstanding this, it is respectfully asserted that a sufficient difference in scope exists between the claims as to the "fob-like structure to allow the cartridge to be clipped to clothing" and the "structure configured to attach the cartridge to clothing and clothing accessories," which has been held to be enough (see MPEP § 706.03(k) "Indeed, a mere difference in scope between claims has been held to be enough.") The American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2000 defines "fob" as a "short chain or ribbon attached to a pocket watch and worn hanging in front of the vest or waist"; or an "ornament or seal attached to such a chain or ribbon." To this end, an adornment that hangs from a short chain, ribbon or the like attaching e.g. a pocket watch to a person's vest or waist is not synonymous with any and all structure configured to attach to clothing and clothing accessories, and constitutes more than even a mere difference in scope.

Double patenting cannot exist within, or as between the Claims of a single patent application. The doctrine of double patenting seeks to prevent the unjustified extension of patent exclusivity beyond the term of a patent. The public policy behind this doctrine is that the public should be able to act on the assumption that upon the expiration of the patent it will be free to use not only the invention claimed in the patent but also modifications or variants which would have been obvious to those of ordinary skill in the art at the time the invention was made, taking into account the skill in the art and prior art other than the invention claimed in the issued patent. See, *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982) (Double patenting results when the right to exclude

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granted by a first patent is unjustly extended by the grant of a later issued patent or patents). Before consideration can be given to the issue of double patenting, two or more patents or applications must have at least one common applicant. Since the doctrine of double patenting seeks to avoid unjustly extending patent rights at the expense of the public, the focus of any double patenting analysis necessarily is on the claims in the multiple patents or patent applications involved in the analysis. See Definition of Double Patenting, MPEP § 804.

If the examiner views this as a substantial concern, applicants' will consider canceling Claims 9 and/or 45, for example by examiner's amendment, if doing so will facilitate the prosecution of the application. If so, and if the examiner would like to discuss applicant's invention prior to issuing an action, the examiner is urged to call the applicants' attorney at the telephone number set forth below.

CASSETTE TAPE ELECTRO-MECHANICAL PLAYER DEVICES

Among the new grounds raised by the patent examiner, it is now asserted that U.S. Patent No. 6,327,633 to Chawla et al. for "Solid state audio system" issued December 4, 2001 ("Chawla") teaches that the player provides power to the cartridge via a power generator connected to the gears of its cassette, such that the cartridge is devoid of a power source when the player is not turning the gears of the cassette (i.e., that the player is not patentably different from an analog cassette player with cassette tape electro-mechanical player devices). Leaving aside the issue of a power generation within the Chawla cassette itself, and for purposes of expediency and to reduce issues in the instant amendment after final, applicants have amended Independent Claims 1 and 27 to recite the player being "devoid of cassette tape electro-mechanical player devices" as well as being devoid of a processor to clarify that devoid of a power source does not encompass "when the player is not turning the gears of the cassette." Further Original Claim 3 and previously presented Claim 27 are for the first time rejected under 35 U.S.C. § 102 novelty. With all due respect, it was not anticipated that the recitation "where the player includes a power supply configured to supply power to the cartridge when the cartridge is received by the player" as recited in Original Claim 3 may have been

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considered to read on the player turning the gears of the cassette as a "power supply" of the player. It was not considered such when these claims were rejected under § 103. Thus to clarify, Claim 3 also is amended to recite the player including an electrical power source configured to supply electrical power to the cartridge when the cartridge is received by the player.

The examiner asserts regarding claims 3 and 27 that "Chawla teaches that the player provides power to the cartridge via a power generator connected to the gears of the cassette. The cartridge is devoid of a power source when the player is not turning the gears of the cassette." Assuming arguendo that claim 3's recitation of the player including "a power supply configured to supply power to the cartridge" could be construed as such, the claim may be defined further to recite an electrical power source. Thus for clarity claim 3 is amended as discussed above and claims 1 and 27 are amended to recite that "the player is devoid of cassette tape electro-mechanical player devices."

**PLAYER COMPRISING A BATTERY OR OTHER POWER SUPPLY
SEPARATE FROM THE CARTRIDGE TO POWER THE PROCESSING
SYSTEM; MERE ROTATIONAL MECHANICAL MOVEMENT IMPARTED
FROM STANDARD AUDIO-CASSETTE PLAYER IS NOT A POWER SUPPLY**

Since independent claim 38 recites "the portable player further comprising a battery or other power supply separate from the cartridge to power the processing system" that claim already defines the player providing power (comprising a battery or other power supply) to power the processing system; such being separate from the cartridge, the rejection of claim 38 is traversed. Chawla uses a standard audio-cassette player, and no known audio-cassette players provide power coupling to tape housings from the player's power supply separate from the cartridge to the cartridge's processing system. The Chawla power generator 165 on the Chawla cartridge for powering its processing system is not separate from the Chawla cartridge and is not on the player as recited in applicants' claim 38. Moreover, the rotation of the Chawla gear 120 driven by the standard audio-cassette player cannot correspond to applicants' recited battery or

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other power supply of the player to power the processing system, and further mere rotational mechanical movement imparted from the standard audio-cassette player is not a power supply and cannot correspond to claim 38's recited battery or other power supply of the player separate from the cartridge. Chawla neither discloses nor suggests an audio-cassette player providing the processing system power to its tape cartridge housing from the player's power supply separate from the cartridge. To the contrary Chawla contemplates power either via the generator on the cartridge (not separate from the cartridge), or external power e.g. with an automobile Audio-cassette player with its power source as the cigarette lighter outlet in the automobile.

Applicants' device advantageously has two parts: (1) a cartridge that contains all of the electronics (i.e, silicon) of an amusement system, while its (2) player is simply electrical in nature, i.e., switches, batteries, speaker, etc. The system architecture as claimed, "where the cartridge includes memory, a processing system, programming executable by the processing system to produce electrical signals representative of sound from the data representative of sound, and at least one connector configured to releasably connect the cartridge to a player" and with the "player to receive electrical signals representative of sound from the cartridge and to produce sound ... where the player includes controls configured to trigger the cartridge to produce electrical signals representative of sound and to transmit those signals to the transducer to produce sound vibrations, but where the player is devoid of a processor to process the electrical signals received from the cartridge" is totally unlike any system produced to date and neither anticipated nor suggested by the prior art.

Cited individually and in view of art considered well-known to the examiner under 35 U.S.C. § 103 obviousness, Chawla relates to a system that provides audio signals when played in a standard audio-cassette player used in automobiles, home stereo systems etc. Chawla teaches a casing provided of the same size and shape of a standard audio-cassette tape including an audio tape, a sensing mechanism for signals indicating a speed and a direction of travel of the audio tape, a processor coupled to the sensing mechanism and a memory card coupled to the processor for storing digitized audio

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information. An audio transfer system is coupled to the processor and magnetically coupled to the audio tape for transferring audio signals onto the tape corresponding to the digitized audio information. As described a memory card also may be included for stored digitized audio information with the processor coupled to the memory card and a D/A converter that outputs an analog audio signal. A plurality of control inputs are selectable for several states such that selected portions of the digitized audio information processed with the standard audio-cassette player facilitate output to the D/A converter in response to the one or more of these several states. Chawla utilizes a standard audio-cassette player, and provides a casing of the same size and shape as that of a standard audio-cassette tape housing including audio tape therein.

Respectfully, Independent Claims 1, 27 and 38 should be allowed, and pending Claims 2-25, 28 and 39-47 depending from Independent Claims 1, 27 and 38 should also be allowed.

**APPLICANTS' SYSTEM IS AN ALTERNATIVE TO EXISTING
CASSETTE PLAYERS, CASSETTE TAPE ELECTRO-MECHANICAL PLAYER
DEVICES, COMPACT DISC PLAYERS, AND OTHER SUCH ITEMS**

As described, applicants' system is an alternative to existing cassette players, cassette tape electro-mechanical player devices, compact disc players, and other such items in that it allows a user to conveniently produce sound, using a cartridge that stores, processes, and also controls data representative of sound and/or images, etc. The cartridge may include a single chip or integrated circuit, with the memory, processing, and other functions all performed by the chip mounted on a printed circuit board. Further regarding Claims 4, 7-10, 18-20, 22, 28, and 44-46 rejected under 35 U.S.C. § 103 for obviousness, neither Chawla, Douglas, Maskovich, Bell, Scott, Lebensfeld, May nor any other prior art of record individually or in proper combination suggests such separation of electrical from electronic, in which control portion (configured with battery and speaker) to trigger via connector are separated out from the processor/ memory storage/ cartridge

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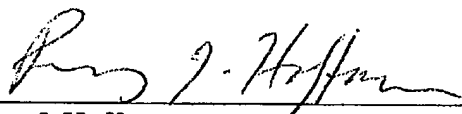
portion (to combine to produce electrical signals representative of sound and to transmit those signals to the transducer to produce sound).

Withdrawal of the outstanding Final Action and timely allowance of the pending claims is respectfully requested. In view of the foregoing, Applicant has placed the case in condition for reconsideration and respectfully requests allowance of pending claims 1-25, 27-28 and 38-47.

If the Examiner would like to discuss Applicant's invention prior to issuing an action, the Examiner should feel free to contact the undersigned attorney.

Respectfully submitted,

Dated: February 27, 2006


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Attorney Docket No. previously 090455-9313 (now 1-002)